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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,578	03/08/2002	Tsung Ming Ou	USDP1531T-TB	2823
30265	7590	10/04/2005	EXAMINER	
RAYMOND Y. CHAN			WONG, STEVEN B	
108 N. YNEZ AVE., SUITE 128			ART UNIT	
MONTEREY PARK, CA 91754			PAPER NUMBER	

3711

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/092,578

Applicant(s)

OU, TSUNG MING

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-23 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 13-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kralik (4,660,831) in view of Ou (5,759,123). Note the basis for the rejections set forth in the Office Actions mailed October 6, 2004 and May 27, 2005. Regarding the added limitation for the ball cover, Kralik includes a ball cover (14, 16) that encloses the liner assembly. The liner assembly (18) overlaps the inner surface of the cover and obviously supports it.

Regarding new claim 18, attention is directed to column 3, lines 48-61 of Kralik stating that the panels of the liner assembly (18) are oval in shape. Regarding the limitation for the liner piece to be compressed and vulcanized, these limitations relate to the method of manufacture. Determination of patentability is based on the product itself and not the process or method of production. See MPEP 2113. The reference to Kralik merely need teach integrally united liner pieces to teach the limitations. Moreover, Ou teaches for the rubber to be compressed and vulcanized.

Regarding claim 19, again, the limitations directed to the compression and vulcanization of the rubber piece and fabric lining to form the integral liner are related to the method of manufacture. The claim is rendered obvious by the teachings of Kralik in view of Ou because Kralik teaches an integrally formed liner comprising a fabric lining and an ethylene vinyl acetate layer and Ou teaches that forming layers of a game balls using integrally formed fabric linings and rubber layers are known in the art.

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Regarding claims 20-23, note the rejection of claims 15-17. The limitations relating to the press mold relate to the method of manufacture of the liner assembly and are not given patentable weight in an apparatus claim.

***Response to Arguments***

3. Applicant's arguments filed September 2, 2005 have been fully considered but are not deemed to be persuasive. Regarding the applicant's argument (a) that Kralik does not provide four elliptical cover skins and four construction liners, attention is directed to column 3, lines 48-61 of Kralik. Here, Kralik states that the liner assembly is formed from preferably four panels (30A-30D) that are oval in shape. Kralik adds that these panels are attached in face-to-face relation with the carcass (14) and the padding (16). The carcass comprises four sections (34A-34D) and the padding is similarly shaped. The padding and carcass comprise the cover skins.

Regarding the applicant's argument (b) that the liner piece is compressed and vulcanized from a rubber piece and a fabric lining, the rejection is over the combination of Kralik in view of Ou. Kralik teaches a fabric lining and an ethylene vinyl acetate layer, however, Kralik also states that other liner assemblies may be utilized. The reference to Ou teaches that it is well known in the art to provide a layer for a game ball that comprises a rubber piece and a fabric lining. It would have been obvious to one of ordinary skill in the art to replace the vinyl acetate layer with rubber in order to take advantage of that material's well known physical characteristics.

Regarding the applicant's argument © that the liner piece is compressed and vulcanized, these limitations relate to the process of manufacture of the lining assembly. As stated above,

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these limitations relate to the process or method of manufacture and do not determine the patentability of the claim. See MPEP 2113. .

Regarding the applicant's argument (d), as stated above, the reference to Kralik provides a suggestion to modify the liner assembly by substitution of other materials. The reference to Ou teaches advantages for the use of rubber in a layer of a game ball.

Regarding the applicant's arguments directed to the Ou reference, the rejection is over the combination of Kralik in view of Ou. The reference to Ou is cited merely as a teaching that it is well known in the art of game balls to include in a fabric layer a layer of rubber. Thus, to replace the vinyl acetate layer of Kralik with a rubber layer would have been obvious to one of ordinary skill in the art given the teaching of Ou.

Regarding the applicant's argument that an American football does not require two carcasses, this modification of the Kralik reference is not being applied. As stated above, the reference to Ou is relied upon for teaching that it is known in the art to form a layer assembly from a combination of rubber and fabric. It would have been obvious to one of ordinary skill in the art to modify the liner assembly of Kralik by replacing the vinyl acetate layer with a rubber layer in order to take advantage of that particular material. The applicant misunderstands the rejection if he believes the reference to Kralik is being modified to include two carcasses. Instead, the liner assembly of Kralik is merely being modified to replace the single layer of ethylene vinyl acetate with a rubber layer.

Regarding the applicant's argument that neither reference teaches a construction liner comprising a compressed and vulcanized integral liner piece, first, this limitation relates to the process of manufacture of the liner assembly. Second, the rejection is over the combination of

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Kralik in view of Ou. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

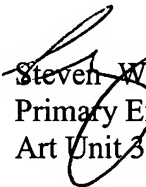
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
October 3, 2005